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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/126,806	07/31/1998	RICHARD M. ANDREWS	BD-03533	9325
7590 05/20/2005			EXAMINER	
MARY E PORTER NORTON COMPANY 1 NEW BOND STREET PO BOX 15138 WORCESTER, MA 016150138			MORGAN, EILEEN P	
			ART UNIT	PAPER NUMBER
			3723	
DATE MAILED: 05/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 09/126,806	Applicant(s) ANDREWS ET AL.	
	Examiner Eileen P Morgan	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-10 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1,2,3,8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Holzapfel et al.-5,842,912.

Holzapfel discloses a rotary profile dressing tool having a rigid disc-shaped core (302) of metal, having an abrasive rim (308) of diamond particles (inserts) which are bonded to the core by an active braze, wherein the rim has cutout portions having a backing area (bottom surface) that is unitary with core.

Claims 1, 2,3,6,8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Goers-6,123,612.

Goers discloses a rotary profile dressing tool having a rigid disc-shaped core of metal, having an abrasive rim of diamond particles which are bonded to the core by an active braze, wherein a backing element 12 unitary with carrier 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-7, 9, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holzapfel or Goers, alone

Holzapfel and Goers do not disclose the exact brazing material or amounts (%). However, it would have been obvious to one of ordinary skill in the art at time invention was made to use a braze that includes bronze, copper, and tin, since it has been held to be within the general skill of the worker in the art to select known material on the basis of its suitability for the intended use as a matter of obvious design choice when general conditions of a claim are disclosed in the prior art, and discovering the optimum or workable ranges involves only routine skill in the art. The size of the diamond grains would have been an obvious design expedient dependent on machining parameters.

Response to Arguments

Applicant's arguments filed 1-26-05 have been fully considered but they are not persuasive. Remarks drawn to Section 102(b) and 102(a) have been considered and those rejections have been withdrawn. Arguments drawn to the primary references not

being a rotary profile dressing tool is unfounded. Both of these references show a dressing tool with a core and an abrasive rim around at least one surface of the periphery of the core. The claim does not identify the specifics of the 'periphery' of the core. These dressing tools are indeed a rotary profile dressing tool. What constitutes 'profile'? These tools can dress disc tools which have a flat 'profile' and therefore read on the claimed invention. The arguments drawn to 'an abrasive rim free of a backing element' are not germane to the claimed invention. Arguments drawn to 'the rim is self-supporting without a backing element' are also not germane to the claimed subject matter. Claims 1, 3-7,9-10 do not exclude the backing. The brazing material would be an obvious design choice dependent on its suitability for its intended use.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen P Morgan whose telephone number is 703.308.1743. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703.308.2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3723

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EM
May 16, 2005



EILEEN P. MORGAN
PRIMARY EXAMINER